

Appl. No. 10/053,387  
Amdt. dated March 4, 2005  
Reply to Final Office Action of January 6, 2005

Docket No. 70377-010200

### REMARKS

The Office Action issued by the Examiner and the citations referred to in the Office Action have been carefully considered. Claim 1 has been amended. No new subject matter has been added.

### REJECTIONS UNDER 35 U.S.C. § 103

The Examiner has rejected claims 1, 9, 11, 12, 14, 15, 16, and 32-38 under §103(a) as being unpatentable over Berg, et al. (U.S. 4,841,962) in view of Cilento, et al. (U.S. 6,270,794), and Claim 17 as being unpatentable over Berg, et al. (U.S. 4,841,962) in view of Cilento and in further view of Chen (U.S. 6,303,700).

With regard to Applicants' arguments made in the response dated October 1, 2004, the Examiner responds by stating that the features relied upon by the Applicants to overcome the prior art are not present in the rejected claims. Furthermore, the Examiner states that although these features are found in Applicants' specification, the limitations are not read into the claims. Thus, it appears that the Examiner would require Applicants to import these distinguishing features into the present claims to overcome Berg, et al. Accordingly, Applicants have amended independent Claim 1 to disclose an adhesive layer containing EPDM. Therefore, for the following reasons, the present application is not anticipated by Berg, et al. or any combination of the cited references.

#### **Berg, et al. fail to teach all the elements of newly amended Claim 1**

First, Berg, et al. do not teach all the elements of newly amended Claim 1. To establish *prima facie* obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art. *In re Royka*, 490 F.2d 981, 180 USPQ 580 (CCPA 1974). As previously submitted, Berg, et al. do not teach a hydrocolloid composition with an adhesive layer containing EPDM. Specifically, the EPDM described in Berg, et al, is located in an *outer layer* of a backing and in a second layer of the backing, and is not part of a hydrocolloid composition

Appl. No. 10/053,387

Amdt. dated March 4, 2005

Reply to Final Office Action of January 6, 2005

Docket No. 70377-010200

providing an adhesive layer. (See Figure 1 of Berg, et al., Col 5 lines 4-36 and 41-68). As evidenced by Figure 1 in Berg, et al. and the specification, the layers containing EPDM are only located in the backing and do not come into contact with the skin. Conversely, the present disclosure and newly amended Claims recite EPDM as part of a hydrocolloid composition providing an adhesive layer. This feature is not taught or suggested by Berg, et al. In other words, the EPDM disclosed in Berg, et al. is simply physically and functionally different than the EPDM disclosed in newly amended Claim 1 and does not disclose all the elements of newly amended Claim 1. Therefore, it is respectfully submitted that newly amended Claim 1 overcomes the Examiner's rejection for that least fact and further in view the arguments stated below.

**Berg, et al. in Combination with Cilento do not render Claim 1 obvious**

Also, the Examiner states that although Berg, et al. do not expressly teach the ratio of ethylene to propylene in the EPDM or the exact concentration of the hydrophilic material in the composition or the inclusion of butyl rubber, that Cilento teaches that a portion of the polyisobutylene matrix can be substituted with butyl rubber. Further the Examiner states that it would have been obvious to one skilled in the art to add butyl rubber to the polyisobutylene (PIB). Thus, the Examiner concludes that the combination of these references, Berg, et al. and Cilento, render Applicant's claims obvious.

However, as shown above, Berg, et al. do not teach a hydrocolloid composition providing an adhesive layer containing EPDM as provided for in the present application. The fact the Examiner states that Cilento provides for PIB in the adhesive portion of a dressing (col. 2, lines 45-57) and that Berg, et al. do not expressly teach the claimed invention is not surprising, since Berg, et al. only consider and teach EPDM as part of a backing. Thus, according to these assertions, Examiner's combination would yield a dressing with EPDM in the backing layer (Berg, et al.) and PIB in the adhesive portion (Cilento). This is Examiner's suggested combination, EPDM in the backing layer with PIB in the adhesive portion, which is very different from the recitation of newly amended Claim 1 and its dependent claims. The present claims do not disclose EPDM in the backing, but EPDM in the adhesive. Furthermore, the

present claims disclose PIB as mixed with the EPDM and located in the adhesive portion. Therefore, the combination of Berg, et al. and Cilento does not teach or suggest all the claim features recited by the present claims and it is respectfully submitted that newly amended Claim 1 and its dependent claims overcome the Examiner's rejection.

#### Claim 17

Also, the Examiner rejected Claim 17 as being unpatentable over Berg, et al. (U.S. 4,841,962) in view of Cilento and in further view of Chen (U.S. 6,303,700). However, as stated above, Berg, et al. do not teach all of the elements of Claim 1 from which Claim 17 depends. Thus, because Berg, et al. do not teach all elements of Claim 17, Examiner's combination with Cilento and Chen cannot make Claim 17 obvious.

#### Claims 9, 11, 12, 14, 15, 16, and 32-38

Furthermore, Claims 9, 11, 12, 14, 15, 16, and 32-38 all depend from Claim 1. If an independent claim is nonobvious under 35 U.S.C. 103, then any claim depending therefrom is nonobvious. *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988). As stated above, Claim 1 is not obvious. Therefore, because Claims 9, 11, 12, 14, 15, 16, and 32-38 depend from Claim 1, they are not obvious for the same reasons as Claim 1. Therefore, it is respectfully submitted that all of the Examiner's rejections under 103 have been overcome. Applicants respectfully request that these rejections be withdrawn.

#### Conclusion

Applicants have complied with all requirements made in the above-referenced communication. Should any matters remain that the Examiner believes could be resolved in a telephone interview, the Examiner is respectfully requested to telephone the Applicants' undersigned agent.

Office Action of January 6, 2005

Docket No. 70377-010200

This response is being timely filed and no fee is believed due. However, if Applicants are mistaken, the Commissioner is hereby authorized to charge any required fee in connection with the submission of this paper, now or in the future, or credit any overpayment to Account No. 50-2638. Please ensure that Attorney Docket Number 70377-010200 is referred to when charging any payments or credits for this case.

Respectfully submitted,

GREENBERG TRAURIG, LLP

By



E. Nair Flores

Reg. No. 54,103

Tel.: (310) 586-6511

Date: March 4, 2005

Customer Number 33717  
Greenberg Traurig, LLP  
2450 Colorado Avenue, Suite 400  
Santa Monica, California 90404

la-fs1v259106v01\70377.010200